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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,439	02/06/2004	Leonard J. Gaik	1685-2/AMK	5149
38735 7590 11/24/2008 DIMOCK STRATTON LLP 20 QUEEN STREET WEST SUITE 3202, BOX 102 TORONTO, ON M5H 3R3 CANADA			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/772,439

**Applicant(s)**

GAIK, LEONARD J.

**Examiner**

THUY VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 24, 2008, wherein claims 1-30 are currently pending.

#### ***Claim Status***

Claim 1 is as followed:

1. A method of arranging for a provision of music from a provider of music to an operator of a public medium comprising the following steps:

a) acquiring from the operator a right to play a selection of music in said public medium; and

b) transferring said right to play music to the provider of music.

Note: for convenience, letters (a)-(b) are added to the beginning of each step.

In step (a), as for the term "to play a selection of music in said public medium", this is not a positively recited method step but, rather as "intended use" of the item "a right". Similarly, in step (b), the term "to play" is interpreted for the same reason as shown in step (a). Therefore, the claim appears to read as below:

A method of arranging for a provision of music from a provider of music to an operator of a public medium comprising the following steps:

a) acquiring from the operator a right; and

b) transferring said right to the provider of music.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated above, claim 1 deals with a "arranging for a provision of music from a first party (provider of music) to a second party (operator) with 2 steps of:

- (a) acquiring an item (right) from a second party (operator), and
- (b) transferring the item (right) to the first party (provider of the music).

1) It's not clear who is carrying out step (a) and who is carrying out step (b). The claim appear to read that there is a 3<sup>rd</sup> party involved and it's the 3<sup>rd</sup> party who carries out both steps of acquiring an item from a 2<sup>nd</sup> party and transfer the item to the 1<sup>st</sup> party. If it's otherwise, then the claim needs to be corrected to clarify the issues.

2) It's not clear whether the two steps of "acquiring an item (right)" and "transferring the item (right)" to the provider of music (first party) meets the scope of the claim which is "arranging for a provision of music from a first party (provider of music) to a second party (operator)".

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-30** are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims **1, 11, 19**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of "*acquiring....., transferring....., delivering....., playing....., arranging....., selecting.....*" is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilks (US Patent Application Publication US 2002/0129693).

**As for independent claim 1**, Wilks discloses a method of arranging for a provision of music from a provider of music to an operator of a public medium comprising the following steps:

acquiring from the operator a right to play a selection of music in said public medium

[see pars. 0008-0009, 0016, 0025, 0048-0049; figures 1 and 6; interactive multimedia system (IMS 12) allows a user e.g. operator or business owner (restaurant owner, or bar, or night club) to search the selected song to downloaded and authorizes to play songs].

transferring said right to play music to the provider of music [...sending and receiving the selection of song from (IMS 12) to the remote server (RS 18) /provider of music); see par. 0035, lines 4-13 and figure 1].

**As for claim 2**, Wilks discloses delivering said selection of music from said provider of music to said operator [see par. 0008, lines 1-6; par. 0041]; and playing said selection in said public medium [see par. 0008, lines 1-6; par. 0010, lines 1-5; par. 0012].

**As for claim 3**, Wilks discloses the step of selecting the operator [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

**As for claim 4**, Wilks discloses the step of selecting the provider of music [see par. 0012, lines 4-6];

**As for claim 5**, Wilks discloses the step of selecting the operator [...operator such as restaurant, bars and client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

**As for claim 6**, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [...see par. 0012, lines 3-5 and figure 3].

**As for claim 7**, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par.

0031, lines 12-13, lines 22-24].

**As for claim 8**, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

**As for claim 9**, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, record distributor, a recording studio, an individual artist, an individual, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

**As for claim 10**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 11**, Wilks discloses a method of acquiring music for an operator of a public medium to play in said medium comprising the following steps:

arranging with the operator to find a provider of music based on a set of criteria [...arranged by type of music, artist name, music type; see par. 0017, lines 3-8; par. 0040, lines 4-8 and figures 3 and 4];

selecting an appropriate provider of music based on said set of criteria; and [...selection of songs from a variety of music types; see par. 0012; par. 0017, lines 3-8 and figures 3-4].

arranging for the provider of music to acquire from the operator a right to play a selection of music in said public medium [...distribution of copyrighted music to businesses and permits a business operator to select songs to be played; see par. 0007, lines 1-5; par. 0010, lines 1-5].

**As for claim 12**, Wilks disclose further comprising the step of delivering said music from the provider of music to the operator [see par. 0008, lines 1-6].

**As for claim 13**, Wilks discloses wherein the provider of music is selected according to a pre-selected set of criteria provided by the operator [...remote multimedia server (RS 18) has created a menu contain the music criteria for user select; see par. 0037, lines 11-21].

**As for claim 14**, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [see par. 0012, lines 3-5 and figure 3].

**As for claim 15**, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

**As for claim 16**, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].



**As for claim 17**, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

**As for claim 18**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 19**, Wilks discloses a method of arranging a business transaction comprising the following steps:

selecting a provider of music [...selecting a variety of artist; see par. 0012; lines 3-6];

selecting an operator of a public medium wherein said medium is appropriate for playing music of the provider of music based on a set of pre-determined criteria provided by said operator [...interactive multimedia system (IMS12) provides a menu with including the music criteria for a user to chose and play; see par.0014, lines 12-14; par. 0016; par. 0017, lines 4-9; par. 0037, par. 0048; and figures 1-2].

arranging for the provider to acquire from the operator a right to play a selection of music in said public medium [...interactive multimedia system (IMS 12) allows a user to search the selected song to downloaded and authorizes to play songs; see par. 0016, par. 0031, lines 21-23, par. 0048-0049 and figure 1].

**As for claim 20**, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

**As for claim 21**, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

**As for claim 22**, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

**As for claim 23**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 24**, Wilks disclose a method of conducting a business transaction between a provider of music and an operator of a public medium {see comprising the step of arranging for the acquisition of a right to play a selection of music in said public medium by the provider from the operator [...authorizes to play songs from the operator (IMS 12); see par. 0031, lines 1-7; lines 21-23 and figure 1].

**As for claim 25**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 26**, Wilks discloses a method for an operator of a public medium to acquire music for playing in said public medium comprising the step of transferring to a provider of music a right to play a selection of music in said public medium [...sending and receiving the selection of song form (IMS 12) to the remote server (RS 18)/provider of music); see par. 0035, lines 4-13 and figure 1].

**As for claim 27**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 28**, Wilks discloses a method for a provider of music to acquire the right to play music in a public medium comprising the step of acquiring from an operator of a public medium a right to play a selection of music in said public medium [see pars. 0008-0009, 0016, 0025, 0048-0049; figures 1 and 6; interactive multimedia system (IMS 12) allows a user e.g. business owner (restaurant owner, or bar, or night club) to search the selected song to downloaded and authorizes to play songs].

**As for claim 29**, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

**As for claim 30**, Wilks disclose wherein there is no cost to a member of the public for accessing said music from said public medium [see par. 0006, lines 1-4].

***Response to Arguments***

8. Applicant's arguments filed on July/24/2008 have been fully considered but they are not persuasive.

1) With respect to the 112, 2<sup>nd</sup> paragraph rejections, applicant's comment of "Applicant respectfully submits that is clear from a literal reading of the claim that it is in fact the provider of music who acquires the right to play his music in the public medium and then provides the music to the operator of the public medium once this right has been acquired" is noted, but these are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no clear language in claim 1 describes the underlined arguments shown above. The argued limitation appears to be in dependent claim 2 which should be added to claim 1 in order to overcome the 112, 2nd rejection above.

2) Applicant stated that Wilks does not teach the feature "*provide the music to owners of public media; offering a right to a provider of music to play its music in a public medium*". The examiner respectfully disagrees. Applicant's attention is directed to at least pars. 0008-0009, 0016, 0048-0049 wherein Wilks discloses "*providing the music to the business owners e.g. restaurant owner, bar, or night club*".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., *provide music to owners of public media in a cost effective manner, purchasing from the operator of a public medium a right to play a selection of music in the public medium at a pre-determine time for a pre-determined length of time and selling the right to play music to the provider of music*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Note:** The rejected claim is recited (claims 18, 23 and 29) "*the right to play a selection of music in said medium is at pre-determined of time and for a pre-determined length of time*" which is taught in Wilks par. 0031; However, the claim doesn't show the features of purchasing from the operator of a public medium a right to play a selection of music; and selling the right to play music to the provider as stated above.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689